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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,972	10/31/2001	Christopher Rogers	DEP 0639	6510

27777 7590 03/24/2004
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EXAMINER

LEWIS, RALPH A

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,972

Applicant(s)

ROGERS ET AL.

Examiner

Ralph A. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 15-18, 22-24 and 28-44 is/are rejected.
- 7) ☒ Claim(s) 13, 14, 19-21 and 25-37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8, 10</u> . | 6) <input type="checkbox"/> Other: _____ |

Objection to the Abstract

In response to the previous objection to the abstract being written as a single sentence claim, applicant merely deleted most of the originally filed abstract leaving a brief single sentence broadly specifying structure. Applicant's attention is again directed to MPEP 608.01(b) for guidance in drafting abstracts. More particularly, the MPEP indicates that when the invention is directed to an apparatus then the abstract should include the apparatuses "organization and operation."

Rejections based on Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

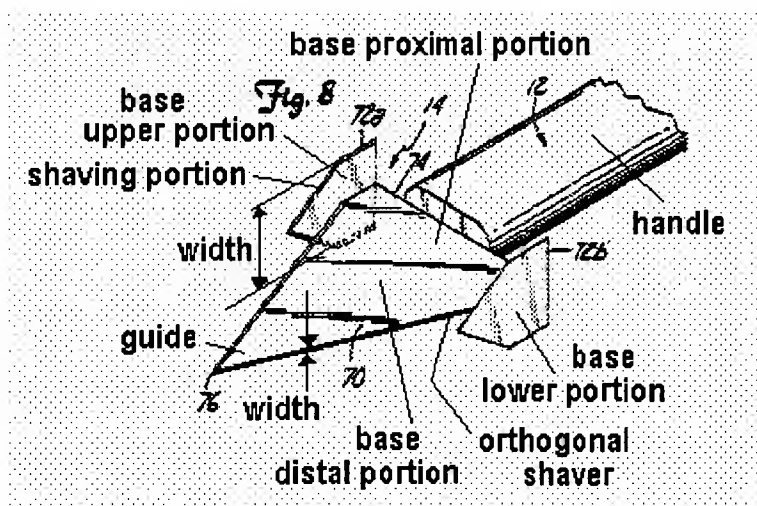
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12, 15, 18, 22-24 and 38-44 are rejected under 35 U.S.C. 102(a) as being anticipated by Ray et al (US 5,649,945).

Note the identified structure in Ray et al Figure 8. The intent by applicant that tool be used with base upper and lower portions in a horizontal position rather than a vertical position, fails to provide for any objectively ascertainable structural distinctions between the claimed device and that disclosed by Ray et al.



In regard to claim 4, note the optional handle of Figure 9. In regard to claim 5, note the retraction means 28 (recess).

In response to the present rejection applicant argues that Ray et al fails to disclose a "guide" and then declares that a "guide is a non-cutting member that helps align the chisel if the chisel were somehow misaligned, thereby insuring that equal amounts of material are removed from the upper and lower workpiece portions." Unfortunately, the rejected claims fail to include such defining language. The examiner

would readily withdraw the present rejection if such language were included in the claim. Applicant's apparent position that the examiner and the public somehow read applicant's mind and interpret the general term "guide" in such a manner is unreasonable.

In regard to claim 43, applicant argues that the claim requires an intermediate portion narrowing distally to form secondary orthogonal shavers trailing the upper and lower shaving portions. It is noted that applicant's claim explicitly only speaks of "portions" – a "lower portion", "upper portion", "upper shaving portion " etc. – thus if any "portion" of the prior art device meets the requirement of the claimed "portion" then the limitation is met. Applicant's arguments are much more narrow than the explicitly stated claim language.

In regard to claim 44, the reference clearly discloses constant upper and lower "portions." Again applicant argues that his claims are much narrower than the explicit language of the claims.

Claim 43 is rejected under 35 U.S.C. 102(e) as being anticipated by Nicholson et al (US 6,241,733).

Note upper shaving portion 61 and lower shaving portion opposite thereof and secondary orthogonal shavers 64.

In response to the present rejection applicant argues that the "intermediate base portion is connected only to the upper and lower portions." Again it appears that

applicant has construed the term "portion" much too narrowly. A "portion" may include a whole element or only a part of an element.

Claim 44 is rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent 210316.

Note Figure 8 with intermediate portion 22.

In response to the present rejection applicant argues that claim 44 requires that the outer surfaces on the upper and lower portions are smooth. Again it appears that applicant has construed the term "portion" much too narrowly. A "portion" may include a whole element or only a part of an element.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ray et al (US 5,649,945).

The specifically claimed angles would have fallen well within a range one of ordinary skill in the art would have found to be obvious.

Allowable Subject Matter

The "bulging I-beam" and "bow-tie" I-beam limitations of claims 13 and 14 are interpreted as defining structure substantially as illustrated in applicant's Figures 4b and 4c and consequently are objected to and would be allowable if rewritten in independent form to include all of the limitations of the claims from which they depend. The "neck" limitation of the guide is interpreted as requiring a narrowed portion and the "head" limitation is interpreted as requiring a structure wider than the "neck", accordingly claims 19-21 and 25-37 are objected to and would be allowable if rewritten in independent form to include all of the limitations of the claims.

Prior Art

Applicant's information disclosure statements of November 20, 2003 and December 31, 2003 have been considered initialed copies enclosed herewith.

Action Made Final

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(703) 308-0770**. Fax (703) 872-9306. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (703) 308-2582.

R.Lewis
March 18, 2004



Ralph A. Lewis
Primary Examiner
Au3732